

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bruce Bent et al.
Title: MONEY FUND BANKING
SYSTEM
Appl. No.: 10/825,440 Reissue
Filing Date: 4/14/2004
Examiner: Jagdish Patel
Art Unit: 3693
Confirmation Number: 8474

SUPPLEMENTAL LITIGATION NOTIFICATION

Mail Stop REISSUE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This communication is provided pursuant to 37 C.F.R. 1.178(b), concerning the above-referenced patent application.

Pursuant to 37 C.F.R. 1.178(b), Applicants are providing a supplemental litigation notice of a concurrent proceeding in which the U.S. Patent No. 6,374,231 (the '231 patent) is involved.

Applicants' representative was notified by the firm of Amster, Rothstein & Ebenstein LLP, acting as litigation counsel for the assignee Island Intellectual Property LLC (defined as "Island IP"), Island IP's exclusive licensees, LIDs Capital LLC ("LIDs") and Intraspew LLC, and their sublicensee, Double Rock Corporation, collectively, "the Island IP Parties," that the suits previously notified to the USPTO to enforce U.S. Patent No. 7,509,286 (a continuation-in-

part of patent applications: Ser. No. 09/677,535, filed on Oct. 2, 2000, Ser. No. 10/071,053, filed Feb. 8, 2002, and Ser. No. 10/382,946 filed Mar. 6, 2003, all these applications are continuations-in-part of patent application Ser. No. 09/176,340, now U.S. Patent No. 6,374,231, currently in reissue), U.S. Patent No. 7,519,551, (a continuation-in-part of patent application Ser. No. 09/176,340, filed on Oct. 21, 1998 now U.S. Patent No. 6,374,231, currently in reissue, and a continuation-in-part of patent application Serial No. 09/677,535), and U.S. Patent No. 7,536,350 (a continuation-in-part of patent application Ser. No. 09/677,535, filed Oct. 2, 2000, and a continuation-in-part of patent application Ser. No. 10/071,053, filed Feb. 8, 2002, both of which are continuations-in-part of patent application Ser. No. 09/176,340, filed Oct. 21, 1998 and now U.S. Patent No. 6,374,231, currently in reissue), against several accused infringers in the U.S. District Court for the Southern District of New York, case no. 09 CV 2675, in the U.S. District Court for the Southern District of New York,

that the following Stipulations and Orders were filed:

Stipulation and Order of dismissal of Promontory Interfinancial Network LLC and MSBC Securities Corporation;

Stipulated Dismissal of Counts I-III of Defendant Promontory Interfinancial Network, LLC's Counterclaim Without Prejudice;

Statement of Non-Liability / Covenant Not To Sue;

and

Stipulated Dismissal of Deutsche Bank AG Without Prejudice.

Copies of these Stipulations of Dismissal and other documents are submitted herewith.

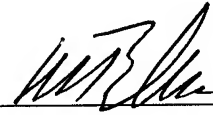
The Commissioner is hereby authorized to charge any deficiency or credit any over-payment to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, applicants hereby petition for such extension under

37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date December 7, 2009

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By 

William T. Ellis
Attorney for Applicants
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USDS SDNY DOCUMENT ELECTRONICALLY FILED DOC #: DATE FILED: 10-29-09

MAKRENO

UNITED STATES DISTRICT COURT FOR THE
SOUTHERN DISTRICT OF NEW YORK

ISLAND INTELLECTUAL PROPERTY LLC,
LIDS CAPITAL LLC, DOUBLE ROCK
CORPORATION, and INTRASWEEP LLC,

Plaintiffs,

v.

PROMONTORY INTERFINANCIAL
NETWORK, LLC, MBSC SECURITIES
CORPORATION, DEUTSCHE BANK AG,
DEUTSCHE BANK TRUST COMPANY
AMERICAS, and TOTAL BANK SOLUTIONS,
LLC,

Defendants.

09-CV-2675 (VM) (AJP)

STIPULATION AND ORDER

IT IS HEREBY STIPULATED AND AGREED by and between the undersigned counsel for Island Intellectual Property LLC, LIDS Capital LLC, Double Rock Corporation and Intrasweep LLC (collectively, the "Island Parties"), and counsel for Promontory Interfinancial Network, LLC and MBSC Securities Corporation (collectively, the "Promontory Defendants"), that all claims asserted by the Island Parties against the Promontory Defendants, and all counterclaims asserted by the Promontory Defendants against the Island Parties, are dismissed with prejudice.

The Island Parties and the Promontory Defendants will each bear their own fees and costs in this action with respect to the claims asserted by the Island Parties against the Promontory Defendants and the counterclaims asserted by the Promontory Defendants against the Island Parties.

The clerk is hereby directed that Promontory Interfinancial Network, LLC and MBSC Securities Corporation shall be removed from the case caption henceforth.

Dated: New York, New York
October 28, 2009

MAYER BROWN LLP

AMSTER, ROTHSTEIN & EBENSTEIN LLP

By: Robert D. Gilbert / RDG
Robert D. Gilbert, Esq.

By: Charles R. Macedo / CM
Charles R. Macedo, Esq. (CM 4980)

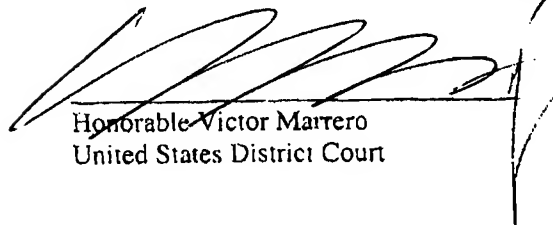
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*Counsel for Defendants Promontory
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Securities Corporation*

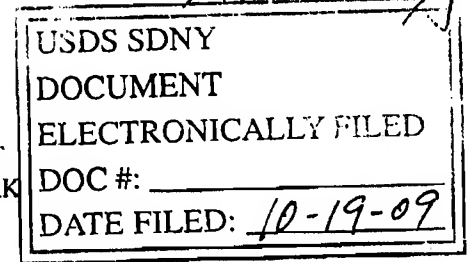
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IslandIP@arelaw.com

*Counsel for Plaintiffs Island Intellectual
Property LLC, LIDs Capital LLC, Double
Rock Corporation and Intrasweep LLC*

SO ORDERED 28 October 2009


Honorable Victor Marrero
United States District Court

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK



-----x
ISLAND INTELLECTUAL PROPERTY LLC,
LIDS CAPITAL LLC, DOUBLE ROCK
CORPORATION, and INTRASWEEP LLC,

Plaintiffs,

v.

PROMONTORY INTERFINANCIAL
NETWORK, LLC, MBSC SECURITIES
CORPORATION, DEUTSCHE BANK AG,
DEUTSCHE BANK TRUST COMPANY
AMERICAS, and TOTAL BANK SOLUTIONS,
LLC,

Defendants.
-----x

Civil Action No.: 09 Civ. 2675 (VM)

**STIPULATED DISMISSAL OF
COUNTS I-III OF DEFENDANT
PROMONTORY INTERFINANCIAL
NETWORK, LLC'S
COUNTERCLAIM
WITH PREJUDICE**

Whereas, on June 25, 2009, Promontory Interfinancial Network, LLC ("Promontory") asserted declaratory judgment counterclaims against Island Intellectual Property LLC ("Island IP"), Intrasweep LLC ("Intrasweep"), LIDs Capital LLC ("LIDs Capital") and Double Rock Corporation ("Double Rock") (collectively "the Island Parties") in the United States District Court for the Southern District of New York, Civil Action No. 09-cv-2675, seeking among other things, a declaratory judgment that U.S. Patent No. 6,374,231 ("the '231 patent") is not infringed, not valid and not enforceable (Counterclaim Counts I-III) (D.I. 27); and

Whereas, the Island Parties and Defendant Promontory have agreed to the attached Statement of Non-Liability/Covenant Not to Sue with respect to the '231 patent.

IT IS HEREBY STIPULATED AND AGREED THAT:

(1) Pursuant to Rule 41(a)(1)(A)(ii) of the Federal Rules of Civil Procedure, Promontory dismisses Counts I-III of its Counterclaim in the above action with prejudice; and,

(2) Promontory and the Island Parties will each bear their own fees and costs in this action with respect to Counts I-III of Promontory's Counterclaim against the Island Parties.

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*Counsel for Defendant Promontory
Interfinancial Network, LLC*

AMSTER, ROTHSTEIN & EBENSTEIN LLP

By: 

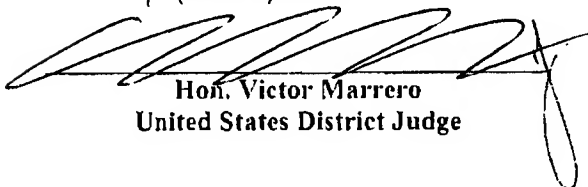
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*Counsel for Plaintiffs Island Intellectual
Property LLC, LIDs Capital LLC, Double
Rock Corporation and Intrasweep LLC*

IT IS SO ORDERED.

Dated: New York, New York
19 October, 2009


Hon. Victor Marrero
United States District Judge

Anthony F. Lo Cicero (AL 7538)
Charles R. Macedo (CM 4980)
Benjamin Charkow (BC 4455)
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Attorneys for Plaintiffs
Island Intellectual Property LLC
LIDs Capital LLC, Double Rock Corporation,
and Intrasweep LLC

**UNITED STATES DISTRICT COURT FOR THE
SOUTHERN DISTRICT OF NEW YORK**

**ISLAND INTELLECTUAL PROPERTY LLC,
LIDS CAPITAL LLC, DOUBLE ROCK
CORPORATION, and INTRASWEEP LLC,**

Plaintiffs,

v.

**PROMONTORY INTERFINANCIAL
NETWORK, LLC, MBSC SECURITIES
CORPORATION, DEUTSCHE BANK AG,
DEUTSCHE BANK TRUST COMPANY
AMERICAS, and TOTAL BANK SOLUTIONS,
LLC,**

Defendants.

Civil Action No.: 09 Civ. 2675 (VM)

STATEMENT OF NON-LIABILITY / COVENANT NOT TO SUE

WHEREAS, Island Intellectual Property LLC ("Island IP") is the owner of all rights,
title and interest in U.S. Patent No. 6,374,231 ("the '231 patent");

WHEREAS, LIDs Capital LLC ("LIDs Capital") is the exclusive licensee of Island IP for
the '231 patent for providing cash management services for broker dealers and asset managers,

and Double Rock Corporation ("Double Rock") is a sublicensee of LIDs Capital for the '231 patent with respect to providing cash management services for broker dealers and asset managers;

WHEREAS, Intrasweep LLC ("Intrasweep") is the exclusive licensee of Island IP for the '231 patent for providing cash management services for banks, and Double Rock is a sublicensee of Intrasweep for the '231 patent with respect to providing cash management services for banks;

WHEREAS, Island IP has filed reissue application Ser. No. 10/825,440 on April 14, 2004 to reissue the '231 patent, cancelling all of the claims of the '231 Patent as issued on April 16, 2002 (i.e., claims 1-19), and seeking new claims, which reissue application is currently pending;

WHEREAS, on March 24, 2009, Promontory Interfinancial Network, LLC ("Promontory") filed a declaratory judgment lawsuit against Island IP, LIDs Capital and Double Rock in the United States District Court for the Eastern District of Virginia ("the Virginia Court"), Civil Action No. 1:09-316, seeking, among other things, a declaratory judgment that the '231 patent is not valid, not infringed and not enforceable; and

WHEREAS, after the Virginia Court transferred that lawsuit, on June 1, 2009, Promontory reasserted claims for declaratory judgment against Island IP, LIDs Capital, Intrasweep and Double Rock (collectively "the Island Parties") in the United States District Court for the Southern District of New York, Civil Action No. 09-cv-2675, seeking among other things, a declaratory judgment that the '231 patent is not valid, not infringed and not enforceable.

In an effort to resolve this dispute, the Island Parties hereby affirm that Promontory or any successors-in-interest have no liability to the Island Parties or any successors-in-interest to the '231 patent for infringement of any and all claims issued on April 16, 2002 in the '231 patent

and the Island Parties and any successors-in-interest to the '231 patent will not sue Promontory or any successors-in-interest for infringement of any and all claims issued on April 16, 2002 of the '231 patent with regard to any Promontory product or Promontory service previously or currently in existence, or any future Promontory product or Promontory service including, but not limited to Promontory's IND and IND2 products or services.

The Island Parties further hereby affirm that no customer, broker-dealer or third party using a Promontory product or Promontory service or providing a Promontory product or Promontory service shall have any liability to the Island Parties or any successors-in-interest to the '231 patent for infringement of any and all claims issued on April 16, 2002 in the '231 patent with regard to any Promontory product or Promontory service previously or currently in existence, or future Promontory product or Promontory service including, but not limited to Promontory's IND and IND2 products or services.

The Island Parties further hereby affirm that the Island Parties and any successors-in-interest to the '231 patent will not sue any customer, broker-dealer or third party using a Promontory product or Promontory service or providing a Promontory product or Promontory service for infringement of any and all claims issued on April 16, 2002 of the '231 patent with regard to any Promontory product or Promontory service previously or currently in existence, or future Promontory product or Promontory service including, but not limited to Promontory's IND and IND2 products or services.

Notwithstanding the above, if new claims emerge from the currently pending reissue proceeding or any future reissue or reexamination proceedings that are not substantially identical to the claims of the '231 patent issued on April 16, 2002, and if there is an issue of infringement by Promontory and/or its customers of the non-substantially identical claims, the Island Parties

reserve the right to commence an action against Promontory and/or its customers on these non-substantially identical claims and Promontory and/or its customers would be free to raise a specified defense as allowed by law or equity.

This Statement of Non-Liability/Covenant Not to Sue supersedes and replaces the prior Statements of Non-Liability/Covenants Not to Sue submitted to the Virginia Court in Civil Action No. 1:09-316.

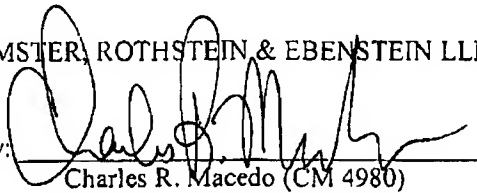
Dated: October 19, 2009

Respectfully submitted,

DOUBLE ROCK CORPORATION, ISLAND
INTELLECTUAL PROPERTY LLC,
INTRASWEEP LLC and LIDs CAPITAL LLC

By Counsel

AMSTER, ROTHSTEIN & EBENSTEIN LLP

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Intrasweep LLC

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DATE FILED: 11/19/09

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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ISLAND INTELLECTUAL PROPERTY LLC, LIDS CAPITAL LLC, DOUBLE ROCK CORPORATION, and INTRASWEEP LLC,	:	Civil Action No.: 09 Civ. 2675 (VM) (AJP)
	:	
Plaintiffs,	:	
	:	
v.	:	STIPULATED DISMISSAL OF
	:	DEUTSCHE BANK AG
DEUTSCHE BANK AG, DEUTSCHE BANK TRUST COMPANY AMERICAS, and TOTAL BANK SOLUTIONS, LLC,	:	<u>WITHOUT PREJUDICE</u>
	:	
Defendants.	:	

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Whereas counsel for Defendants Deutsche Bank AG and Deutsche Bank Trust Company Americas represents that Defendant Deutsche Bank AG is not involved in the offering and/or operation of the Deutsche Bank Insured Deposit Program;

IT IS HEREBY STIPULATED AND AGREED THAT:

- (1) Pursuant to Rule 41(a)(1)(A)(ii) of the Federal Rules of Civil Procedure, Deutsche Bank AG is hereby dismissed on consent and without prejudice from the above action;
- (2) Plaintiffs and Defendant Deutsche Bank AG will each bear their own fees and costs in this action with respect to the cause of actions asserted by and against Deutsche Bank AG; and
- (3) Deutsche Bank AG shall be removed from the case caption.

SIDLEY AUSTIN LLP

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*Counsel for Plaintiffs Island Intellectual
Property LLC, LIDs Capital LLC, Double
Rock Corporation and Intrasweep LLC*

IT IS SO ORDERED.

Dated: New York, New York
11/19, 2009

HON. ANDREW J. PECK
Hon. Victor Marrero
United States Magistrate Judge
Southern District of New York

ANDREW J. PECK
United States Magistrate Judge
Southern District of New York

BY ECF